

**REMARKS**

Claims 1, 7 and 16 have been amended. Claims 1, 3, 5, 7, 9-14, 16 and 20 remain pending in the application. Favorable reconsideration of the application is respectfully requested.

**Claim Rejections - 35 U.S.C. §103**

Claims 1, 3, 5, 7, 9-14, 16 and 20 stand rejected under 35 U.S.C. 103(a) as being unpatentable over United States Patent No. 3,741,786 to Torrey.

Torrey is designed to overcome problems associated with adhesive dispensing tapes that are uniformly and completely coated with adhesive. See Col. 1, lines 27-39. In particular, when dispensing adhesive from these uniformly coated tape rolls, the prior art tape tends to string or stretch during dispensation. Clearly, Torrey is directed to solving a specific problem – dispensing a large portions of adhesive while avoiding stringing or stretching of the adhesive on the tape. It is this function that is achieved by the Torrey tape – a function discussed throughout Torrey. See also Col. 2, lines 33-38.

Importantly, the configuration of the adhesive on the Torrey tape is not provided for aesthetic appeal, it is purely functional. Indeed, Torrey recites several functional reasons for its configuration of adhesive on the tape: (1) including adhesive-free edges to aid in guiding the tape in a dispensing means, Col. 3, lines 21-26; (2) the adhesivity of the

adhesive selected; (3) the affinity of the intended substrate; and (4) the degree of binding desired, Col. 3, lines 69-75.

Applicant acknowledges that Torrey states the pattern of the segments is "not narrowly critical" and also "[t]he spacing between segments is not narrowly critical..."; however, Applicant disagrees with the Examiner's suggestion that the pattern is a matter of design choice. Col. 3, lines 57-75. Instead, Torrey states that the adhesive spacing (and therefore the pattern of adhesive) on the tape is "... a function of the adhesive coverage desired per unit area of a substrate." This is clearly not matter of design choice or for aesthetic reasons, in fact, Col. 3, lines 27-50 and Col. 4, lines 1-10 of Torrey describe in detail the how the adhesive should be configured on the tape in order to overcome the problems of the prior art. There are specific functional reasons for the Torrey adhesive configuration. As such, Applicant asserts that Torrey fails to teach or suggest adhesive segments aligned in a side-by-side relation, and importantly, aligned in such an arrangement that each individual adhesive segment is individually exposable and dispensable to an abutting planar surface.

More particularly, Torrey does not describe, teach or suggest an adhesive dispensing tape that is configured so that each individual adhesive segment is individually exposable and dispensable to an abutting planar surface when the carrier tape is transversely flexed. As recited above, Torrey teaches a dispensing tape that overcomes the problems of prior art tapes that include a uniformly coated layer of adhesive. As

such, Torrey provides adhesive configurations that are substantially noncontiguous. See again Col. 4, lines 1-10.

However, there is no discussion, teaching or suggestion in Torrey to expose and dispense one individual adhesive segment to a substrate. Additionally, there is no discussion anywhere in Torrey to configure the adhesive segments on the tape so that adhesive is dispensed when the Torrey tape is transversely flexed. Each and every embodiment described in Torrey is configured to dispense a large portion of the adhesive segments on the tape. This is certainly reflected in the Torrey description of its adhesive patterns – which are defined in terms of adhesive per unit area of a substrate. Torrey is clearly intended and used to dispense a quantity of adhesive to a single given substrate.

Torrey is not directed to exposing and dispensing individual adhesive segments to an abutting planar surface when the carrier tape is transversely flexed. In contrast, Torrey specifically includes in its definition of "substantially noncontiguous" segments that have adhesive residue connecting them on the tape. Even with respect to Fig. 4 of Torrey, a single segment is not shown removed. Applicant asserts that "any portion of the adhesive" as defined by Torrey refers to a large portion, or alternatively, more than one adhesive segment. Otherwise, the advantage and function of Torrey is not realized – that is, dispensation of a large amount of adhesive to a substrate "without cutting the carrier tape or the adhesive." Col. 6, lines 32-37.

As further evidence of the definition of "a portion", Torrey discusses a significant advantage of its adhesive patterns, which is, when applied to a substrate "the portion of adhesive" functions as "discrete adhesive segments." Col. 6, lines 47-53. If Torrey was designed to expose and dispense an individual segment to an abutting planar surface, the segment would itself be "discrete" and the novel utility of Torrey would be read entirely out of the disclosure. Again, the problem addressed by Torrey is to prevent such a portion of adhesive from expanding, shrinking and curling on a substrate, which is a problem when adhesive is applied in a continuous layer. Col. 6, lines 56-58. Any definition of "a portion" that includes a single adhesive segment is inaccurate and vastly outside the scope of the Torrey teaching. To read such a definition into the Torrey reference, modifies the function, purpose and operability of the Torrey reference.

Additionally, one skilled in the art would not be motivated by Torrey to provide an adhesive dispensing tape that is configured so that each individual adhesive segment is individually exposable and dispensable to an abutting planar surface when the carrier tape is transversely flexed – as a reading of Torrey would not motivate one to make the leap from dispensing large portions of adhesive to a substrate without cutting the adhesive or the tape to dispensing a single adhesive segment to a substrate.

Accordingly, Applicant asserts that the present claims distinguish over Torrey by reciting an adhesive dispensing tape that is configured so that each individual adhesive

segment is individually exposable to an abutting planar surface when the carrier tape is transversely flexed Torrey is distinguished from the present invention.

In Applicant's adhesive dispensing tape, the adhesive segments are spaced apart transversely and longitudinally, providing margins between adjacent adhesive segments of sufficient width and length such that each of the adhesive segments is individually exposable to an abutting planar surface when the carrier tape is transversely flexed, and an individual adhesive segment can be exposed for adhering to a surface without the risk of the surface picking up multiple adhesive segments. In the transfer tape disclosed by Torrey, the close proximity of the adhesive segments shown in Figs. 1 and 2 will result in multiple adhesive segments being dispensed during a given application.

Therefore, in view of the distinctions noted and for the advantages attendant thereto, it is respectfully submitted that Claims 1, 7 and 16 clearly distinguish over Torrey, and not obvious in view of Torrey and are believed to be patentable over Torrey.

Claim 3, which is dependent upon Claim 1, Claims 9-11 and 14 which are dependent upon Claim 7, and Claim 20, which is dependent on Claim 16, are believed to be allowable along with respective parent claims.

### **Summary**

In summary, Claims 1, 3, 5, 7, 9-14, 16 and 20 are believed to be allowable for the reasons given herein. Accordingly, these claims remain pending following entry of this Amendment, and are believed to be in condition for allowance at this time. As such,

Applicants respectfully request entry of the present Amendment and reconsideration of the application, with an early and favorable decision being solicited. Should the Examiner believe that the prosecution of the application could be expedited, the Examiner is requested to call Applicants' undersigned representative at the number listed below.

Respectfully submitted:

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